

REMARKS/ARGUMENTS

Applicants have received the Office Action dated September 21, 2007, in which the Examiner: 1) rejected Claims 1, 2, 8-10, 14-16, 18 and 20 under 35 U.S.C. §103(a) as being unpatentable over Kim et al.(US Patent Application Publication No. 2004/0136390)(hereinafter *Kim*) in view of Ho et al. (US Patent Application Publication No. 2002/0120740)(hereinafter *Ho*); 2) rejected Claims 3 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Kim* in view of *Ho*, and further in view of Picone (US Patent No. 4,815,134)(hereinafter *Picone*); 3) rejected Claims 4 and 11 under 35 U.S.C. 103(a) as being unpatentable over *Kim* in view of *Ho*, and further in view of Mason (US Patent Application Publication No. 2003/0063598)(hereinafter *Mason*); 4) rejected Claims 5, 12, and 19 under 35 U.S.C. §103(a) as being unpatentable over *Kim* in view of *Ho*, and further in view of Narasimhan (US Patent No. 7,016,651)(hereinafter *Narasimhan*); and rejected Claims 6 and 13 under 35 U.S.C. §103(a) as being unpatentable over *Kim* in view of *Ho*, in further view of *Narasimhan* and further in view of Chen et al. (US Patent Application Publication No. 2005/0025143)(hereinafter *Chen*).

As a first preliminary matter: In respond, Applicants have assumed that the reference to “Mason (US Patent Application Publication No. 2003/0063598)” (present Office Action, page 6, item 4) should instead be “Huo (US Patent Application Publication No. 2003/0063598)”. According to the U.S. Patent Office database, the designated publication lists David Di Huo as the inventor, and lists correspondence to go to Ryan, Mason & Lewis LLP.

As a second preliminary matter: Concurrent with the original filing of the present application, a Notice of Related Application was submitted. In that Notice, it was requested that the Examiner acknowledge in writing in the next Office Action, that he has received and officially consider that Notice. As nothing has been received to-date from the Examiner, and there is no reference in the present Office Action to this Notice, Applicants respectfully repeat their request. A courtesy copy of the Notice as filed is enclosed herewith.

Claims 1-20 as originally filed remain pending in this application. Applicants thank the Examiner for indicating that Claim 7 would be allowable if rewritten in

independent form. Applicants respectfully decline to so amend at this time. Based upon the arguments presented below, Applicants believe all claims to be in condition for allowance.

Claim Rejections Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1, 2, 8-10, 14-16, 18 and 20 under 35 U.S.C. §103(a) as allegedly obvious over *Kim* in view of *Ho*. Applicants respectfully traverse these rejections.

The burden of establishing a prima facie case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). In establishing a prima facie case for obviousness, it is often necessary “to look to interrelated teachings of multiple pates, the effects of demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 82 USPQ2d 1385, 1396 (2007)(Slip Opinion No. 04-1350 (U.S. April 30, 2007) at 14). Indeed, “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.” *Id.* slip opinion at 2 (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). This analysis should be made explicitly. *Id.* slip opinion at 14 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Additionally, a claim having several elements is *not* proved obvious merely by demonstrating that each of its elements was known in the prior art. *Id.* As such, the obviousness inquiry does not hinge on demonstrating that elements were known in the art. Rather, the obviousness inquiry focuses on whether the claimed subject matter would have been obvious to persons having ordinary skill in the art in view of

the demands and practices of the design community at the of filing of the application.
See *id.*

Moreover, the Applicant submits that, during the patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. See *In re Prate*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. §2111 (describing the standards for claim interpretation during prosecution). Indeed, the *specification* is “the primary basis for construing the claims.” *Philips v AWH Corp.*, 415 F.3d 1303, 1315 (Fed.Cir. 2005). It is usually dispositive. See *id.* Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. See *In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); see also M.P.E.P. §2111. That is, recitations of a claim must be read as they would be interpreted by those of ordinary skill in the art. See *Rexnord Corp. v. Laliram Corp.*, 60 U.S.P.Q.2d 1851, 1854 (Fed. Cir. 2001); see also M.P.E.P. §2111.01. In summary, an Examiner, during prosecution, must interpret a claim recitation as one of ordinary skill in the art would reasonably interpret the claim in view of the specification. See *In re American Academy of Science Tech Center*, 70 U.S.P.Q.2d 1827 (Fed. Cir. 2004).

Independent Claim 1 recites, “[a]n arrangement for avoiding contention on a communication medium among devices including at least a transmitter and a receiver, the arrangement comprising:

a first portion configured to instruct the receiver to indicate that the communication medium is busy for a time period substantially longer than an actual frame transmission period being sent from the transmitter to the receiver;
and

a second portion configured to prohibit the receiver from transmitting on the communication medium during the time period.

Independent Claim 10 recites, “[a] method for avoiding contention on a communication medium by devices including at least a transmitter and a receiver, the method comprising:

instructing a receiver to indicate that the communication medium is busy for a time period substantially longer than a frame being sent from the transmitter to the receiver; and

prohibiting the receiver from transmitting on the communication medium during the time period.

Independent Claim 16 recites, “[a] network including a communication medium on which contention is to be avoided, the network comprising:

a transmitting element, configured to transmit on the communication medium, a frame that includes an instruction that the communication medium is busy for a time period substantially longer than an actual transmission time of the frame that includes the instruction; and

a receiving element, configured to receive the frame that includes the instruction, and, in response to the instruction, to refrain from transmitting on the communication medium during the time period, so as to avoid the contention on the communication medium.

Although primary reference *Kim* is missing further claim limitations and element relationships as will be discussed below, Applicant agrees with the Examiner that *Kim* fails to teach or suggest “the second portion configured to prohibit the receiver from transmitting on the communication medium during the time period” (Claim 1). *Ho* is cited to purportedly meet this missing limitation. Unfortunately, the Examiner has failed to make a *prima facie* case for obviousness.

At least one reason: *Kim* further fails to disclose anything which would “indicate that the communication medium is busy for a time period substantially longer than an actual frame transmission period being sent from the transmitter to the receiver” (Claim 1; emphasis added). As a result, *Kim* also fails to disclose “a first portion configured to instruct the receiver to” so indicate (Claim 1). None of the

applied references, including *Ho*, have been cited to meet these additional missing limitations.

Moreover, Applicants agree with the Examiner that primary reference *Kim* fails to teach or suggest “prohibiting the receiver from transmitting on the communication medium during the time period” (Claim 10). *Ho* is cited to purportedly meet this limitation. Unfortunately, the Examiner has failed to make a *prima facie* case for obviousness.

At least one reason: *Kim* further fails to disclose anything which would “indicate that the communication medium is busy for a time period substantially longer than a frame being sent from the transmitter to the receiver” (Claim 10; emphasis added). As a result *Kim* also fails to disclose the functionality of “instructing a receiver” so indicate (Claim 10). None of the applied references, including *Ho*, have been cited to meet these additional missing limitations.

Moreover, Applicants agree with the Examiner that primary reference *Kim* fails to teach or suggest “a receiving element, configured to receive the frame that includes the instruction, and, in response to the instruction, to refrain from transmitting on the communication medium during the time period, so as to avoid the contention on the communication medium” (Claim 16). *Ho* is cited to purportedly meet this limitation. Unfortunately, the Examiner has failed to make his *prima facie* case for obviousness.

At least one reason: *Kim* further fails to disclose anything which would qualify as “an instruction that the communication medium is busy for a time period substantially longer than an actual transmission time of the frame that includes the instruction” (Claim 16; emphasis added). As a result *Kim* also fails to disclose “a frame that includes” such an instruction (Claim 16). None of the applied references, including *Ho*, have been cited to meet these additional missing limitations.

Thus, the missing claimed limitations and relationships in *Kim* and *Ho*, taken together or individually, are in sharp contrast to Applicants’ claimed invention. Thus, independent Claims 1, 10 and 16 are not obvious over *Kim* in view of *Ho*. Accordingly, Applicants respectfully request withdrawal of the rejection under

Section 103 and allowance of independent Claims 1, 10 and 16, as well as all claims depending therefrom. Thus, all Claims 1-20 should be indicated as allowed.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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